

REMARKS

The Final Office Action dated June 7, 2007 contained a final rejection of claims 1-52. The Applicants have amended claims 1, 14, 18, 35 and 42. Claims 1-52 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-52 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Applicants respectfully traverse this rejection and submit that the subject matter of the claims comply with 35 U.S.C. 112, first paragraph. Namely, on page 2 of the Final Office Action dated June 7, 2007, the Examiner improperly concluded that the "...claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of the application was filed, had possession of the claimed invention." Although the Examiner admitted that the specification "...suggests that non-time stamped elements can be separated and be placed at the beginning or end of the timeline...", the Examiner summarily and incorrectly stated that the specification "...fails to provide a detailed description of automatic separation, e.g., by which way such a function is being performed and by which means."

According to Stahelin v. Seher, 24 USPQ2d, 1513 (B.P.A.I. 1992), "[I]t has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement...How such a teaching is set forth, whether by use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which

correspond in scope to the claims *must* be taken as complying with the first paragraph of 35 USC 112 *unless* there is a reason to doubt the objective truth of the statements relied upon there for enabling support." *Id.* At 1516 (citing In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (C.C.P.A 1971)) (emphasis in original).

The Applicants submit that the original specification does not contain any reason to doubt the Figures or description for the claimed elements of "automatically separate non-time stamped media elements and automatically place the non-time stamped media elements at the beginning or end timeline location according to control settings" and "sorting identified media elements according to selected control settings." In fact, the support for these elements can be found throughout the specification and at least in FIGS. 1-3 and paragraphs [0032], [0036], [0038] and [0041] - [0043] of the Application specification (U.S. Patent Publication No. 2004/0205479). For example, paragraph [0036] explicitly states that "...the presentation creation system 110 **automatically composes an initial presentation by sorting the identified media elements** from block 206 according to the selected control settings from block 204....The term "**automatically**" in this context **indicates the ability to create a presentation without further input from the user** after the user indicates completion of the media element identification process of block 206 or that they have completed the editing process of block 214." [emphasis added].

In addition, paragraph [0038] of the Applicants' specification explicitly states that if "...there are image elements, such as digital still images and digital vid-images, that do not have time stamps, the presentation creation system 110 may place the non-stamped image elements **at the beginning, or end**, of the initial presentation according to a **control setting** determined in block 204. Alternatively, the presentation creation system 110 may **separately group the non-stamped image elements for the user to place in the presentation in a later step**, such as the editing of block 214. The presentation creation system 110 completes the composition of the image-track when the images from the media elements identified in block 206 are all placed on the image-track or grouped for insertion in another block of the process." [emphasis added].

Also, paragraph [0043] explicitly states that "...some image boxes, such as first image box 310 and second image box 312, **may overlap** on the image line 304.

Such overlaps may occur if, for example, but not limited to, the image elements were recorded contemporaneously, or if the time stamp associated with the image element has been changed in block 206, or if the time stamp was changed due to an edit in block 214. In these situations, the image elements may have overlapping time stamps associated with the digital data corresponding to the image elements." [emphasis added]. Thus, the specification would be readily understood by any skilled software programmer. Examiners can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999).

Next, the Federal Circuit has clearly stated that patent applications should be written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

For example, the court in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999) concluded that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue. As such, the description in the specification provides enough enabling support for the claimed "dynamically changing the application during server operation without shutting the server down." Thus, for the reasons as set forth above, the Applicant submits that the rejection should be withdrawn because the claims are enabling and comply with 35 U.S.C. § 112, first paragraph.

Further, the Applicant submits that the rejection under 35 U.S.C. Section § 112 should be withdrawn because the Examiner has not provided a prima facie case to support his rejection under U.S.C. Section § 112, first paragraph. In particular, contrary to the Examiner's statement, it is well settled that in order for an Examiner to maintain a prima facie case of not satisfying U.S.C. Section § 112, first paragraph, the Examiner must provide the following: a rational basis as to why the disclosure does not teach or why to doubt the objective truth of the statements in the disclosure

that purport to teach; the manner and process of making and using the invention that corresponds to the scope of the claims to one of ordinary skill in the art requires undue experimentation; and it deals with subject matter that would not already be known to the skilled person as of the filing date of the application. Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co., 228 F.3d 1338, 56 USPQ 1332, 1136 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001).

Merely stating an unsupported conclusion that the specification "... fails to provide a detailed description of automatic separation, e.g., by which way such a function is being performed and by which means." is not enough for the Examiner to maintain a non-enablement rejection. Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999). In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). The CCPA has stated that the "PTO has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling... Showing that the disclosure entails undue experimentation is part of the PTO's initial burden..." In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976). Although the Examiner attempted to bypass this requirement by summarily stating that specification "... fails to provide a detailed description of automatic separation, e.g., by which way such a function is being performed and by which means," the Applicants submit that the Examiner is not permitted to do so.

Moreover, the Examiner is required to set forth a reasonable explanation as to why he believes that the written description does not satisfy U.S.C. Section § 112, first paragraph, for supporting the scope of protection provided by the claim; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement, the rejection must be withdrawn. Because the Examiner has not given a detailed explanation, supported by the record as a whole, why the specification is not enabling, including a showing that the disclosure entails undue experimentation, the rejection must be withdrawn. In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976).

Hence, the Applicants respectfully submit that the original specification complies with the written description requirement with respect to claims 1-52 and the rejection is in error.

The Office Action rejected claims 1-17 and 42-48 under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter.

In response, the Applicants have amended applicable claims as suggested by the Examiner to overcome these rejections.

The Office Action rejected claims 1-52 under 35 U.S.C. 103(a) as allegedly being unpatentable over Miller et al. (U.S. Patent Publication No. 2005/0273789) in view of Balkus et al. (U.S. Patent Publication No. 2004/0268224).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

The Applicants' independent claims now include automatically overlapping media elements on a same track that were recorded contemporaneously. Support for the newly amended features can be found throughout the specification and at least in FIG. 3 and paragraphs [0037] and [0043] of the Application specification (U.S. Patent Publication No. 2004/0205479). For example, paragraph [0037] states that the "...initial presentation preferably comprises an image-track and a soundtrack. The image-track is the visual portion of the presentation." Also, paragraph [0043] states that "...some image boxes, such as first image box 310 and second image box 312, may overlap on the image line 304. Such overlaps may occur if, for example, but not limited to, the image elements were recorded contemporaneously..." Thus, since the original specification discloses two tracks, an audio track and an image track (only one track for images - see paragraph [0037]), and because **overlaps can occur with images** that were recorded contemporaneously (see paragraph [0043]), the claimed feature of automatically overlapping media elements **on a same image track** that were recorded contemporaneously is supported by the original specification.

In contrast, the combined cited references do **not** disclose, teach or suggest this feature of the Applicants' newly claimed invention. In particular, the combined references simply disclose overlapping clips on **different tracks** (see paragraph [0115] of Miller et al.) and time-stamped features (see Abstract of Balkus et al.) and **not** the Applicants' newly amended feature of automatically overlapping media elements **on a same image track** that were recorded contemporaneously. Therefore, clearly, the combined references are missing this feature.

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should not be considered together because Miller et al. teach away from the Applicants' claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, Miller et al. explicitly disclose that "[I]f a **track** contains more than one source clip, the source clips **cannot overlap**. If source clips are to overlap (e.g. fading from one source to another, or having one source obscure another), then **multiple tracks** are used." [emphasis added] (see paragraphs [0187] and [0189] of Miller et al.). As argued above, in contrast, the Applicants' claimed invention discloses that the media elements automatically overlap on a same track that were recorded contemporaneously.

Moreover, Miller et al. explicitly disclose that "...the source clips **must occur next to one another** in the project, (2) the clips appear next to one another in the source, and (3) the clips must share a common pre-processing source chain (i.e., **must require** the same pre-processing)," which is very different from the Applicants' claimed which allows "automatically separating non-time stamped media elements and automatically place the non-time stamped media elements at the beginning or end timeline location according to control settings."

Consequently, the proposed modification or combination would render Miller et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Miller et al. being modified because Miller et al. explicitly cannot overlap source clips on the same track and separation of media elements cannot occur since Miller et al. disclose that source clips **must occur next to one another**.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,

1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicants' claimed elements are not disclosed, taught or suggested by the combined references and because Miller et al. teach away from the Applicant's invention, Miller et al. cannot be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. *MPEP 2143*.

Also, the Examiner is reminded that these references should not be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this teaching away and the failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (*MPEP 2143*).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (*MPEP* § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the

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dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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